

REMARKS

Summary of the Amendment

Claims 1-14, 17-33 and 35-48 are pending with claims 1, 43, 44 and 45 being in independent form.

Summary of the Official Action

In the Final Office Action, the Examiner again withdrew claims 4-7 as being directed to a non-elected species. Additionally, the Examiner rejected claims 1-3, 8-14, 17-33, and 35-48 over the art of record. By the present remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Claims 4-7 Are Withdrawn by the Examiner

Claims 4-7 were withdrawn by the Examiner because, the Examiner asserts, these claims are readable on Figs. 41-42 instead of Figs. 36-40.

While Applicant disagrees that these claims cannot be read on the elected species, Applicant requests that these claims be rejoined if and when claim 1 is found to be allowed/allowable.

Rejection under 35 U.S.C. § 102(b)/103(a)

Applicant respectfully traverses the rejection of claims 41 and 42 under 35 U.S.C. § 102(b) as anticipated by or under 35 U.S.C. § 103(a) as unpatentable over US patent 4,469,110 to SLAMA

alone.

The Examiner asserts that he may properly ignore the lancet device features recited in these claims finds that these claims are disclosed or suggested by SLAMA.

Applicant disagrees. Applicant acknowledges that claims 41 and 42 are method claims which depend from lancet device claim 1. Applicant, however, does not agree that the lancet device features of claim 1 can be ignored.

Method claims 41 and 42 recite features such as "the needle", "the front cover", "the skin-engaging end", the lancet device", and the trigger". Each of these claim features finds antecedent basis in claim 1 from which claims 41 and 42 depend. Thus, it is clear that claims 41 and 42 must be interpreted as reciting the features in claim 1.

As such, claims 41 and 42 cannot be interpreted without any reference to claim 1 as noted by the Examiner.

Applicant submits that the above-noted document fails to disclose or suggest the features recited in at least independent claim 1 in combination with each of claims 41 and 42. Because no proper modification of the above-noted document discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of this document can render unpatentable the combination of features recited in at least these claims.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b)/103(a).

Traversal of Rejection Under 35 USC § 103(a)

Applicant respectfully traverses the rejection of claims 1-3, 8-14, 17-33 and 35-48 under 35 U.S.C. § 103(a) as unpatentable over SLAMA in view of US patent 6,156,051 to SCHRAGA.

The Examiner asserts that the combination of teachings of these documents discloses or suggests the features of the above-noted claims. Applicant respectfully disagrees.

In rejecting each of independent claims 1 and 43-45, the Examiner makes numerous assertions based on SLAMA that are improper. For example, on page 4 of the Final Office Action, the Examiner identifies member 5a of SLAMA as the recited trigger and the recited back cap. The Examiner also argues that SLAMA teaches the recited second stop surface as a surface of the front cover 10.

The former assertion is improper because the Examiner has identified a single feature, i.e., the button 5a of SLAMA, as two different recited features, i.e., the recited trigger and the recited back cap.

Moreover, even if the former assertion were proper (which Applicant disputes), the latter assertion is improper because it is contrary to the express teachings of SLAMA. Contrary to the Examiner's assertions, SLAMA does not provide for contact between a surface of the front cap 10 and the lancet holding member 3. Instead, SLAMA specifically provides for contact between the shaft 5 and the stop surface 7 (see Fig. 3 and col. 3, lines 13-22, 33-38 and 65-68).

Indeed, if SLAMA provided for contact between a surface of the front cap 10 and the lancet holding member 3, SLAMA would no longer have the ability to provide depth adjustment.

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However, SLAMA specifically provides for depth adjustment using the front cap 10 (see col. 3, lines 54-56).

When one properly interprets the recited first stop surface as being on the shaft 5 of SLAMA and notes that SLAMA specifically describes stop surface 7 as the “second stop” (see col. 2, lines 66-68) and further notes that Fig. 1 of SLAMA shows the stop surface of member 5 as being closer to a rear end of the holding member 3 than to a front end, SLAMA cannot be read to teach or suggest any of the following:

a first stop surface that moves with the holding member and being arranged closer to the front end of the holding member than to the rear end of the holding member, a second stop surface non-movably coupled to the body, and the second stop surface extending inwardly from the body and being arranged closer to a front end of the body than to a rear end of the body and between the first stop surface and the skin engaging end (**claim 1**). The shaft 5 is not closer to the front end of the holding member 3 than to the rear end of the holding member 3. Furthermore, the second stop surface 7 is arranged on a wall of the body 2 in SLAMA (i.e., in slot 2a of body 2) and does not extend inwardly from the body. Indeed, if it did, it would likely obstruct the movement of the holding member 3 whose diameter is shown to almost exactly mach an inside diameter of the body 2 (see Figs. 1, 3 and 4);

a first stop surface arranged on a front portion of the holding member and being disposed inside the body and a second stop surface axially retained to a front portion of the body and being disposed inside the body (claims 43-44). The shaft 5 of SLAMA is closer to a rear end of the holding member 3 in Figs. 1 and 3 and, at best, in the middle of the holding member 3 in Fig. 4.

Thus, the shaft 5 cannot be said to be a first stop surface arranged on a front portion of the holding member. Furthermore, the second stop surface 7 is arranged on a wall of the body 2 in SLAMA (i.e., in slot 2a of body 2) and is not inside the body. Indeed, if it were inside body 2, it would likely obstruct the movement of the holding member 3 whose diameter is shown to almost exactly mach an inside diameter of the body 2 (see Figs. 1, 3 and 4);

a first stop surface arranged on the holding member and being disposed inside the body at a location that is closer to a front end of the body than to a rear end of the body when the holding member is in the intermediate position and a second stop surface arranged inside the body and located closer to the front end of the body than to the rear end of the body (**claim 45**). As explained above, the first stop surface is arranged on the shaft 5 of SLAMA and not on the holding member 3. Furthermore, the stop surface of the shaft 5 is not arranged inside the body 2. Instead, it is arranged on the portion of the shaft 5 that moves in slot 2a of the body 2. Moreover, the second stop surface 7 is arranged on a wall of the body 2 in SLAMA and is not inside the body. Indeed, if it were inside body 2, it would likely obstruct the movement of the holding member 3 whose diameter is shown to almost exactly mach an inside diameter of the body 2 (see Figs. 1, 3 and 4).

SCHRAGA does not cure the deficiencies of SLAMA. First, it is submitted that the Examiner has not set forth a proper obviousness basis. The Examiner, for example, references different embodiments of SCHRAGA (e.g., Figs. 3A-B and Fig. 16). Such embodiments are completely different. In Fig. 3A-B, the depth adjustment is provided at the front end of the holding member via devices 72 and 74 and contact is utilized between the surface of member 32 and pin 28' (see Fig. 7), i.e., the depth adjustment and limiting contact features are arranged on opposite ends of

the holding member. In Fig. 16, the depth adjustment is provided at the rear end of the holding member via devices 170 and 172 along with limiting contact between devices 176 and 174. Any obviousness argument based on completely different embodiments must set forth an obviousness basis for combining such different embodiments. This appears absent from the instant Office Action.

It is also submitted that to the extent that the Examiner relies upon Fig. 16 of SCHRAGA as curing the deficiencies of SLAMA, it is submitted that SCHRAGA does not, in point of fact, cure the above-noted deficiencies of SLAMA at least because it also fails to teach or suggest the following claim features:

a first stop surface that moves with the holding member and being arranged closer to the front end of the holding member than to the rear end of the holding member, a second stop surface non-movably coupled to the body, and the second stop surface extending inwardly from the body and being arranged closer to a front end of the body than to a rear end of the body and between the first stop surface and the skin engaging end (claim 1). The first stop surface 176 of SCHRAGA is not closer to the front end of the holding member 30 than to the rear end of the holding member 30. Furthermore, the second stop surface 174 is not arranged closer to a front end of the body than to a rear end of the body and between the first stop surface and the skin engaging end;

a first stop surface arranged on a front portion of the holding member and being disposed inside the body and a second stop surface axially retained to a front portion of the body and being disposed inside the body (**claims 43-44**). Again, the first stop surface 176 of SCHRAGA is

not closer to the front end of the holding member 30 than to the rear end of the holding member 30.

Furthermore, the second stop surface 174 is not axially retained to a front portion of the body.

a first stop surface arranged on the holding member and being disposed inside the body at a location that is closer to a front end of the body than to a rear end of the body when the holding member is in the intermediate position and a second stop surface arranged inside the body and located closer to the front end of the body than to the rear end of the body (claim 45). The first stop surface 176 of SCHRAGA is not disposed inside the body at a location that is closer to a front end of the body than to a rear end of the body when the holding member 30 is in the intermediate position. Furthermore, the second stop surface 174 is not arranged closer to the front end of the body than to the rear end of the body.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claims 1 and 43-45. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of these documents can render unpatentable the combination of features recited in at least independent claims 1 and 43-45.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claims 1 and 43-45 is not rendered obvious by any reasonable inspection of these documents.

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Additionally, Applicant submits that the above-noted dependent claims are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 103(a).

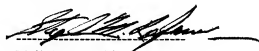
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to refund excess payments and charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Respectfully submitted,
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